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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 09/675,424 | 09/29/2000 | Charles H. Ferguson | 4887-4001US1 | 3865 |
| 7590 | | 08/26/2004 | | |
| Morgan & Finnegan LLP | | EXAMINER | | |
| 345 Park Avenue | | NGUYEN, VAN H | | |
| New York, NY 10154 | | ART UNIT | | |
| | | 2126 | | |
| DATE MAILED: 08/26/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/675,424 | FERGUSON ET AL. | |
| | Examiner | Art Unit | |
| | VAN H NGUYEN | 2126 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/18/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-160 is/are pending in the application.
- 4a) Of the above claim(s) 1-120 and 147-160 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 121-146 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/18/01 and 9/25/0</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election of group XVI (claims 121-146), filed May 18, 2004 is acknowledged.
2. Claims 1-160 are pending in this application.
3. Applicant is required to cancel non-elected claims 1-120 and 147-160 in the next response to this office action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 146 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following phrases lack antecedent basis:

- (i) "said second component" (claim 146, line 7)
- (ii) "said first component" (claim 146, line 7)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 121-131 and 134-146 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Voskuil** (Pub. No.: U.S. 2002/0032768 A1).

8. As to claim 146, Voskuil teaches the invention substantially as claimed including a system for providing a combination of network-based services and non-network based services within a personal computer application (see abstract), comprising:

a means for providing access to network-based services (abstract, lines 2-3) over a network (abstract, lines 3-4) for utilization within the personal computer application (abstract, lines 4-10 and para. 0012), and

a means for providing non-network-based services within the personal computer application (abstract, lines 1-2 and para. 0010) the second component coupled to the first component (see fig.1).

While Voskuil teaches the means for providing access to network-based services, Voskuil does not specifically teach *providing real-time content*.

It would have been obvious to one of ordinary skill in the art to have applied the teachings of Voskuil to include *providing real-time content* because it would have allow the end user computer to immediately receive the requested functions from the server to extend functionality of the end user computer program.

The fact that Voskuil's teachings "end user...connected to...server...via a network such as the Internet" (para.0022) and "an application on the end user computer communicates...receive and execute extension modules that expand the functionality of the application (para.0012) and purpose of communicating and receiving the extension modules via the Internet suggests *providing real-time content*.

9. As to claim 136, the rejection of claim 146 above is incorporated herein in full. Additionally, Voskuil further teaches the network-based services being received from a network (abstract and para 0012).

10. As to claim 137, Voskuil teaches the second component is capable of providing static content along with the network-based services provided by the first component (para. 0024).

11. As to claim 138, Voskuil teaches the network-based services provide dynamic network-based content to a personal computer document, which is opened within the personal computer application (para. 0029).

12. As to claim 139, Voskuil teaches the dynamic network-based content is updated in real-time within the personal computer document opened in the personal computer application, along with static data therein (para. 0029).

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13. As to claim 140, Voskuil teaches the first component comprises developer tools, the developer tools providing the capability for developing personal computer document within network-enabling objects embedded therein (para. 0029 and 0033).

14. As to claim 141, Voskuil teaches the developer tools enable creation of Internet applications using the personal computer application, by providing means for Embedding network-enabling objects in a personal computer document (para. 0029 and 0033).

15. As to claim 142, Voskuil teaches the developer tools comprises a user interface to expose the developer tools to a user (para. 0029).

16. As to claim 143, Voskuil teaches the user interface is a toolbar that exposes a plurality of tool sets to the user within the personal computer application (para. 0029).

17. As to claim 121, the rejection of claim 146 above is incorporated herein in full. Additionally, Voskuil further teaches code associated with the network-enabled personal computer application for interpreting the second component for allowing access to the network-based services within the network-enabled personal computer application (para 0013).

18. As to claim 122, Voskuil teaches the network-based services are received and transmitted over a network (para. 0028 and 0029).

19. As to claims 123-124, refer to claims 138-139 above for rejection.

20. As to claim 125, Voskuil teaches extender routines to support base functionality of the second component, the extender routines being external to the personal computer application; and developer tools (para. 0013).

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While Voskuil teaches providing extended functionality for the personal computer application, Voskuil does not explicitly teach *developing personal computer documents*.

It would have been obvious to one of ordinary skill in the art to have applied the teachings of Voskuil to include *developing personal computer documents* because it would have allow to increase the flexibility in Voskuil's system.

The fact that Voskuil's teachings "the syntax of each XML document...the schema governs which the document arrangements...guarantees that the module will properly interpret the XML" (para.0022) and purpose of arranging and interpreting XML documents suggests *developing personal computer documents*.

21. As to claim 126, Voskuil teaches the developer tools enable creation of Internet applications using the personal computer application, by providing means for embedding network-enabling objects in a personal computer document (para.0033 and 0034).

22. As to claim 127, Voskuil teaches the developer tools are accessible from within the personal computer application (para. 0029).

23. As to claim 128, Voskuil teaches the developer tools comprises a user interface to expose the developer tools to a user (para. 0029).

24. As to claim 129, Voskuil teaches the user interface is a toolbar that exposes a plurality of tool sets to the user (para. 0038).

25. As to claim 130, Voskuil teaches the user interface is exposed to the user within the personal computer application, the user interface appearing in addition to a standard toolbar of the personal computer application (para. 0038).

26. As to claim 131, Voskuil teaches the extender routines are provided as a COM component (para. 0027).

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27. As to claim 144, the rejection of claim 146 above is incorporated herein in full. Additionally, Voskuil further teaches means for interpreting means for providing real-time access to network-based services, the means for interpreting associated with the network-enabled personal computer application for allowing access to the network-based services within the network-enabled personal computer application (para. 0013).

28. As to claim 134, the rejection of claim 146 above is incorporated herein in full. Additionally, Voskuil further teaches extender routines to support base functionality of the second component, the extender routines capable of interpreting the second component for allowing access to the network-based services within the network-enabled personal computer application (para. 0013); and developer-tools, the developer tools providing the capability for developing personal computer documents with network-enabling objects embedded therein, the developer tools accessible within the personal computer application (para. 0029).

29. As to claim 135, Voskuil teaches the extender routines are external to the personal computer application (para. 0029, lines 1-5).

30. As to claim 145, the rejection of claim 146 above is incorporated herein in full. Additionally, Voskuil further teaches means to support base functionality of the means for providing access to network-based services, wherein the means to support base functionality is capable of interpreting the means for providing access to network-based services (para. 0013).

While Voskuil teaches providing extended functionality for the personal computer application, Voskuil does not explicitly teach *developing personal computer documents*.

It would have been obvious to one of ordinary skill in the art to have applied the teachings of Voskuil to include *developing personal computer documents* because it would have allow to increase the flexibility in Voskuil's system.

The fact that Voskuil's teachings "the syntax of each XML document...the schema governs which the document arrangements...guarantees that the module will properly interpret the XML" (para.0022) and purpose of arranging and interpreting XML documents suggests *developing personal computer documents*.

31. Claims 132-133 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Voskuil** (Pub. No.: U.S. 2002/0032768 A1) in view of **Chalas** (U.S. 5,392,386).

32. As to claim 132, Voskuil does not explicitly teach a spreadsheet application.
Chalas teaches a spreadsheet application (col.1, line 17).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Chalas and Voskuil because Chalas's teaching would have provided the capability for improving the flexibility in the Voskuil's system.

33. As to claim 133, Voskuil does not explicitly teach a word processing application.
Chalas teaches a word processing application (col.1, line 16).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Chalas and Voskuil because Chalas's teaching would have provided the capability for improving the flexibility in the Voskuil's system.

Conclusion

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Hughes (U.S. 6345382) teaches "Run-time customization in object-oriented design."

- Bonnell et al. (U.S. 5978594) teaches "Interpretable script language programs are present on all computers in the network, expanding and customizing the functionality of the agent software systems."

- Honda (U.S. 5742767) teaches "Program function extending method and apparatus and data processing method."

- Alfredsson (U.S. 5457798) teaches "Method and computer system for increasing the functionality of a computer program."

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (703) 306-5971. **After mid-October, 2004, the examiner can be reached at (571) 272-3765.** The examiner can normally be reached on Monday-Thursday from 8:30AM - 6:00PM. The examiner can also be reached on alternative Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703) 305-9678.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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